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| 10/697,083      | 10/31/2003  | Wesley Scott Ashton  | ASHTON0009          | 9725             |

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| EXAMINER |
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RODRIGUEZ, RUTH C

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| ART UNIT | PAPER NUMBER |
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3677

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06/08/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/697,083 | <b>Applicant(s)</b><br>ASHTON, WESLEY SCOTT |  |
|                              | <b>Examiner</b><br>RUTH C. RODRIGUEZ | <b>Art Unit</b><br>3677                     |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 21-27,31,36-39 and 42-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38,39,42-45,48 and 49 is/are allowed.
- 6) ☒ Claim(s) 21-27,31,36,37,46 and 47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2009 is/are: a) ☒ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

1. The drawings were received on 25 March 2009. These drawings are approved.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 21-27, 31, 36, 37, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black (US 4,056,951 A) in view of Kaping, Jr. (US 6,026,659) and Lefkowitz (US 4,676,752).

Black discloses a method for dispensing a substance into a mouth, wherein the substance is selected from the group consisting of a variety of perfuming agents (Abstract). The method comprises the steps of: providing a stud (10,30) including a means for dispensing a substance (14,34) formed in a portion of the stud. The means for dispensing a substance contains the substance (perfuming agent). The stud further comprises a bar (22) having ends. A first end member (34,36 or 24) attached to one end of the bar and a second end member (14,16) attached to an other end of the bar. The

first end member removably attaches to the one end of the bar (Figs. 1-3); mounting the bar of the stud in a piercing formed in a wearer's ear (C. 2, L. 1-5); and dispensing the substance (C. 3, L. 53-56). The substance is dispensed by dissolving the substance over time into the air that enters the first or second end members so that the dissolved substance is free to flow from the means for dispensing into the ambient. Black fails to disclose that the substance is dispensed into a mouth, that the substance is a breath freshener or flavoring agent, that the bar is mounted in a fistula formed in the wearer's tongue or in the wearer's lip and the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva so that the dissolved substance is free to flow from the means for dispensing into the wearer's mouth. However, Kaping teaches a method to mounting a mouth and tongue stud (10). The method comprises the steps of: (a) providing a mouth and tongue stud (10). The stud comprises a bar (12) having ends, a first end member (14) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (C. 3, L. 39-42); (b) mounting the bar of the stud in a fistula formed in a wearer's tongue or in the wearer's lip (C. 2, L. 5-31). The stud is selected with a post extending through the ear (C. 1, L. 30-34) and the stud may be positioned on other body parts such as eyebrows, lips, nose bridges, belly buttons or other body parts (C. 1, L. 39-43). Kaping also teaches that the stud has an integrally formed and complementary threaded bore to receive a cap part integrally threaded so as "to provide a body piercing jewelry that is comfortably positionable through a pierced passageway in a body part and retainable in the body part with minimal risk of loosening.

It is another object of the present invention to have a body piercing jewelry that is retainable in a pierced passageway for an extended period of time.” (C. 2, L. 54-60).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the stud being positioned in the mouth when the bar is mounted in a fistula formed in the wearer’s mouth or in the wearer’s lip as taught by Kaping for the stud disclosed by Black so that the substance contained within the stud can be dispensed into the mouth and that the substance is dispensed into the wearer’s mouth by dissolving the substance over time in the wearer’s saliva so that the dissolved substance is free to flow from the means for dispensing into the wearer’s mouth since Black discloses the end members have a plurality of opening that will allow the saliva to enter into the end members just like the air is able to carry the scent of the perfuming agent. Doing so, will be obvious since Kaping teaches that the use of a stud a post extending through the ear and on other body parts such as eyebrows, lips, nose bridges, belly buttons or other body parts is well known the body piercing art. Additionally, the threaded bar and threaded end members provides a stud whose end members can be retained in a pierced passageway for an extended period of time and minimizes the risk of loosening of the end member with respect to the bar. Regarding to the substance being selected from the group consisting of a breath freshener and a flavoring agent, Lefkowitz teaches a device (10) being placed in wearer’s mouth to dispense a flavoring agent and/or breath freshener (32) (L. 3-6 of the abstract). Lefkowitz teaches that the use of medications in combination with other fluids and/or flavoring (C. 3, L. 1-3) is well known in the art. Therefore, it would have been obvious to one having ordinary skill in

Art Unit: 3677

the art at the time the invention was made to dispense medication, fluids and/or flavoring as taught by Lefkowitz in the device disclosed by Black and modified in accordance with the teachings of Kaping so that the substance being selected from the group consisting of a breath freshener and a flavoring agent. Doing so, allows dispensing of a medication in combination with a breath freshener and/or flavoring agent. Especially since breath freshener and flavoring agents are used to provide pleasant fragrances for the user's mouth just like the perfume taught by Abramowitz provides a pleasant fragrance to the use of the earring.

Lefkowitz also teaches that:

- The substance comprises a breath freshener (C. 3, L. 1-3).
- The substance comprises a flavoring agent (C. 3, L. 1-3).
- The substance includes a breath freshener mixed with the flavoring agent (C. 3, L. 1-3).
- A medication is mixed with the breath freshener (C. 3, L. 1-3).
- A medication is mixed with the flavoring agent (C. 3, L. 1-3).
- A medication is mixed with the breath freshener and the flavoring agent (C. 3, L. 1-3).

Regarding claim 31, the same rejection of claim 21 serves to reject claim 31 since the claim limitations are almost the same and Lefkowitz teaches that the substance being used is medication (C. 3, L. 1-3). The use of medication is especially useful when the pierced part of the body has been pierced recently and can be prone to infections and the medication can be used for the infections.

Regarding claim 36, the same rejection of claim 21 serves to reject claim 36 since the claim limitations are almost the same and Black disclose that the bar is a straight solid bar without an internal cavity (Figs. 1-3) and Kaping also teaches that the bar is a straight solid bar without an internal cavity that is made of metal (C. 4, L. 48-67). Therefore, the bar discloses by Black will be a straight solid bar that is without an internal cavity (Figs. 1-3) that is made out of metal as taught by Kaping. The means for dispensing a substance is formed in one or both of the first end member and the second end member (Figs. 1-3).

Regarding claim 37, the same rejection of claim 21 serves to reject claim 36 since the claim limitations are almost the same and Black disclose that the bar is a straight solid bar without an internal cavity (Figs. 1-3) and Kaping also teaches that the bar is a straight solid bar without an internal cavity that is made of metal (C. 4, L. 48-67). Therefore, the bar discloses by Black will be a straight solid bar that is without an internal cavity (Figs. 1-3) that is made out of metal as taught by Kaping. The means for dispensing a substance is formed in one or both of the first end member and the second end member (Figs. 1-3). Additionally, Lefkowitz teaches that the substance being used is medication (C. 3, L. 1-3). The use of medication is especially useful when the pierced part of the body has been pierced recently and can be prone to infections and the medication can be used for the infections.

For claim 46, Black disclose that the bar is a straight solid bar without an internal cavity (Figs. 1-3) and Kaping also teaches that the bar is a straight solid bar without an internal cavity that is made of metal (C. 4, L. 48-67). Therefore, the bar discloses by

Black will be a straight solid bar that is without an internal cavity (Figs. 1-3) that is made out of metal as taught by Kaping.

4. Claims 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abramowitz (US 3,500,829) in view of Kaping, Jr. (US 6,026,659) and Lefkowitz (US 4,676,752).

Abramowitz discloses a method for dispensing a substance (48) into an earlobe. The method comprising the steps of: (a) providing an ear stud including a means (14,16,44) for dispensing a substance (48) formed in a portion of the stud. The means for dispensing a substance contains the substance (Figs. 9 and 10). The stud further comprises a bar (14) having ends, a first end member (44) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (Figs. 9 and 10); (b) mounting the bar of the stud in an aperture formed in a wearer's earlobe (Fig. 10); and (c) dispensing the substance into the earlobe ( Fig. 10). Abramowitz teaches that the stud serves to conveniently and effectively deliver medication or perfume to an aperture in an earlobe allowing healing of the ear and clearing up of infections (C. 1, L. 37-48). Abramowitz fails to disclose that the substance is dispensed into a mouth, that the substance is a breath freshener or flavoring agent, that the bar is mounted in a fistula formed in the wearer's tongue or in the wearer's lip and the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva so that the dissolved substance is free to flow from the means for dispensing into the wearer's mouth. However, Kaping teaches a method to mounting a mouth and tongue stud (10). The method comprises



the steps of: (a) providing a mouth and tongue stud (10). The stud comprises a bar (12) having ends, a first end member (14) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (C. 3, L. 39-42); (b) mounting the bar of the stud in a fistula formed in a wearer's tongue or in the wearer's lip (C. 2, L. 5-31). The stud is selected with a post extending through the ear (C. 1, L. 30-34) and the stud may be positioned on other body parts such as eyebrows, lips, nose bridges, belly buttons or other body parts (C. 1, L. 39-43). Kaping also teaches that the stud has an integrally formed and complementary threaded bore to receive a cap part integrally threaded so as "to provide a body piercing jewelry that is comfortably positionable through a pierced passageway in a body part and retainable in the body part with minimal risk of loosening. It is another object of the present invention to have a body piercing jewelry that is retainable in a pierced passageway for an extended period of time." (C. 2, L. 54-60). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the stud being positioned in the mouth when the bar is mounted in a fistula formed in the wearer's mouth or in the wearer's lip as taught by Kaping for the stud disclosed by Abramowitz so that the substance contained within the stud can be dispensed into the mouth and that the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva so that the dissolved substance is free to flow from the means for dispensing into the wearer's mouth since Abramowitz discloses the bar have an elongated slot that will allow the saliva to enter into the stud and the substance will flow freely since there is nothing

blocking the slot. Doing so, will be obvious since Kaping teaches that the use of a stud a post extending through the ear and on other body parts such as eyebrows, lips, nose bridges, belly buttons or other body parts is well known the body piercing art.

Additionally, the threaded bar and threaded end members provides a stud whose end members can be retained in a pierced passageway for an extended period of time and minimizes the risk of loosening of the end member with respect to the bar. Regarding to the substance being selected from the group consisting of a breath freshener and a flavoring agent, Lefkowitz teaches a device (10) being placed in wearer's mouth to dispense a flavoring agent and/or breath freshener (32) (L. 3-6 of the abstract).

Lefkowitz teaches that the use of medications in combination with other fluids and/or flavoring (C. 3, L. 1-3) is well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to dispense medication, fluids and/or flavoring as taught by Lefkowitz in the device disclosed by Abramowitz and modified in accordance with the teachings of Kaping so that the substance being selected from the group consisting of a breath freshener and a flavoring agent. Doing so, allows dispensing of a medication in combination with a breath freshener and/or flavoring agent. Especially since breath freshener and flavoring agents are used to provide pleasant fragrances for the user's mouth just like the perfume taught by Abramowitz provides a pleasant fragrance to the use of the earring.

Lefkowitz also teaches that:

- The substance comprises a breath freshener (C. 3, L. 1-3).
- The substance comprises a flavoring agent (C. 3, L. 1-3).

- The substance includes a breath freshener mixed with the flavoring agent (C. 3, L. 1-3).

- A medication is mixed with the breath freshener (C. 3, L. 1-3).
- A medication is mixed with the flavoring agent (C. 3, L. 1-3).
- A medication is mixed with the breath freshener and the flavoring agent (C. 3, L. 1-3).

5. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaping, Jr. (US 6,026,659) in view of Abramowitz (US 3,500,829).

Abramowitz discloses a method for dispensing a substance (48) into an earlobe. The method comprising the steps of: (a) providing an ear stud including a means (14,16,44) for dispensing a substance (48) formed in a portion of the stud. The means for dispensing a substance contains the substance (Figs. 9 and 10). The stud further comprises a bar (14) having ends, a first end member (44) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (Figs. 9 and 10); (b) mounting the bar of the stud in an aperture formed in a wearer's earlobe (Fig. 10); and (c) dispensing the substance into the earlobe ( Fig. 10). Abramowitz teaches that the stud serves to conveniently and effectively deliver medication or perfume to an aperture in an earlobe allowing healing of the ear and clearing up of infections (C. 1, L. 37-48). Abramowitz fails to disclose that the substance is dispensed into a mouth, that the substance is a breath freshener or flavoring agent, that the bar is mounted in a fistula formed in the wearer's tongue or in the wearer's lip and the substance is dispensed into the wearer's

mouth by dissolving the substance over time in the wearer's saliva so that the dissolved substance is free to flow from the means for dispensing into the wearer's mouth.

However, Kaping teaches a method to mounting a mouth and tongue stud (10). The method comprises the steps of: (a) providing a mouth and tongue stud (10). The stud comprises a bar (12) having ends, a first end member (14) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (C. 3, L. 39-42); (b) mounting the bar of the stud in a fistula formed in a wearer's tongue or in the wearer's lip (C. 2, L. 5-31). The stud is selected with a post extending through the ear (C. 1, L. 30-34) and the stud may be positioned on other body parts such as eyebrows, lips, nose bridges, belly buttons or other body parts (C. 1, L. 39-43). Kaping also teaches that the stud has an integrally formed and complementary threaded bore to receive a cap part integrally threaded so as "to provide a body piercing jewelry that is comfortably positionable through a pierced passageway in a body part and retainable in the body part with minimal risk of loosening. It is another object of the present invention to have a body piercing jewelry that is retainable in a pierced passageway for an extended period of time." (C. 2, L. 54-60). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the stud being positioned in the mouth when the bar is mounted in a fistula formed in the wearer's mouth or in the wearer's lip as taught by Kaping for the stud disclosed by Abramowitz so that the substance contained within the stud can be dispensed into the mouth, the substance is medication and that the substance is dispensed into the wearer's mouth by dissolving

the substance over time in the wearer's saliva so that the dissolved substance is free to flow from the means for dispensing into the wearer's mouth since Abramowitz discloses the bar have an elongated slot that will allow the saliva to enter into the stud and the substance will flow freely since there is nothing blocking the slot. Doing so, will be obvious since Kaping teaches that the use of a stud a post extending through the ear and on other body parts such as eyebrows, lips, nose bridges, belly buttons or other body parts is well known the body piercing art. Additionally, the threaded bar and threaded end members provides a stud whose end members can be retained in a pierced passageway for an extended period of time and minimizes the risk of loosening of the end member with respect to the bar.

6. Claims 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaping, Jr. (US 6,026,659) in view of Edwards (US 4,943,274) and Lefkowitz (US 4,676,752).

Kaping discloses a method to mounting a mouth and tongue stud (10). The method comprises the steps of: (a) providing a mouth and tongue stud (10). The stud comprises a bar (12) having ends, a first end member (14) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (C. 3, L. 39-42); (b) mounting the bar of the stud in a fistula formed in a wearer's tongue or in the wearer's lip (C. 2, L. 5-31). Kaping fails to disclose that the method further comprises dispensing a substance into a mouth, wherein the substance is selected from the group consisting of a breath freshener and a flavoring agent, the mouth and tongue stud also includes a means for

dispensing a substance formed in a portion of the stud, wherein the means for dispensing a substance contains the substance and dispensing the substance into the wearer's mouth, wherein the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva so that the dissolved substance is free to flow from the means for dispensing into the wearer's mouth. However, Edwards teaches a method for dispensing a substance (22) into an earlobe. The method comprising the steps of: (a) providing an ear stud including a means (16,30,38) for dispensing a substance (22) formed in a portion of the stud. The means for dispensing a substance contains the substance (Figs. 1-4). The stud further comprises a bar (30) having ends, a first end member (50) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (Figs. 1-4); (b) mounting the bar of the stud in an aperture formed in a wearer's earlobe (Fig. 2); and (c) dispensing the substance into the earlobe (C. 3, L. 3-10). Edwards teaches that the stud serves to conveniently and effectively deliver medication to an aperture in an earlobe during the healing period following a piercing operation (C. 1, L. 32-35) and the stud serves to apply medication to the interior of the aperture in the earlobe (C. 3, L. 9-10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a method for dispensing a substance where the stud includes a means for dispensing a substance formed in a portion of the stud where the means for dispensing the substance contains the substance and the substance being dispensed as taught by Edwards in the method disclosed by Kaping with the stud is being used in the mouth and therefore the

substance will be dispensed into the wearer's mouth since the fistula formed in the mouth or tongue is also prone to infections during the healing period following a piercing operation. Doing so, serves to deliver medication conveniently and effectively to a fistula in the wearer's mouth and tongue since both devices deal with piercing on the body. Additionally, Edwards teaches that the stud provides a known technique of dispensing a substance in order to combat infections during the healing period following a piercing operation and therefore it would have been obvious to one having ordinary skill in the art that the stud applying medication to the interior of the fistula in the wearer's mouth and tongue where the medication is selected from a medication for use in the user's mouth just like the stud serves to deliver medication to an aperture in the earlobe during the healing period following a piercing operation. Kaping and Edwards fail to disclose that fail to disclose that the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva so that the dissolved substance flows from the means for dispensing into the wearer's mouth so that the dissolved substance is free to flow from the means for dispensing into the wearer's mouth, however, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention that the substance will be dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva so that the dissolved substance flows from the means for dispensing into the wearer's mouth since after the substance is ejected from the reservoir (16), for the first time or any subsequent time, a vacuum is created in the reservoir and this vacuum will allow the flow of fluids into the reservoir. Since the stud is located in the wearer's mouth a mixture of air and saliva can flow into the reservoir. The saliva that

Art Unit: 3677

flows into the reservoir will mix with the substance and dissolve the substance over time in the wearer's saliva and eventually the dissolved substance flows from the means for dispensing into the wearer's mouth. Regarding to the substance being selected from the group consisting of a breath freshener and a flavoring agent, Lefkowitz teaches a device (10) being placed in wearer's mouth to dispense a medication and/or breath freshener (32) (L. 3-6 of the abstract). Lefkowitz teaches that the use of medications in combination with other fluids and/or flavoring (C. 3, L. 1-3) is well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to dispense medication, fluids and/or flavoring as taught by Lefkowitz in the device taught by Kaping and modified in accordance with the teachings of Edwards so that the substance being selected from the group consisting of a breath freshener and a flavoring agent. Doing so, allows dispensing of a medication in combination with a breath freshener and/or flavoring agent.

Lefkowitz also teaches that:

- The substance comprises a breath freshener (C. 3, L. 1-3).
- The substance comprises a flavoring agent (C. 3, L. 1-3).
- The substance includes a breath freshener mixed with the flavoring agent (C. 3, L. 1-3).
- A medication is mixed with the breath freshener (C. 3, L. 1-3).
- A medication is mixed with the flavoring agent (C. 3, L. 1-3).
- A medication is mixed with the breath freshener and the flavoring agent (C. 3, L. 1-3).



7. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaping, Jr. (US 6,026,659) in view of Edwards (US 4,943,274).

Kaping discloses a method to mounting a mouth and tongue stud (10). The method comprises the steps of: (a) providing a mouth and tongue stud (10). The stud comprises a bar (12) having ends, a first end member (14) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (C. 3, L. 39-42); (b) mounting the bar of the stud in a fistula formed in a wearer's tongue or in the wearer's lip (C. 2, L. 5-31). Kaping fails to disclose that the method further comprises dispensing a substance into a mouth, wherein the substance is medicine, the mouth and tongue stud also includes a means for dispensing a substance formed in a portion of the stud, wherein the means for dispensing a substance contains the substance and dispensing the substance into the wearer's mouth, wherein the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva so that the dissolved substance flows from the means for dispensing into the wearer's mouth. However, Edwards teaches a method for dispensing a substance (22) into an earlobe. The method comprising the steps of: (a) providing an ear stud including a means (16,30,38) for dispensing a substance (22) formed in a portion of the stud. The means for dispensing a substance contains the substance (Figs. 1-4). The stud further comprises a bar (30) having ends, a first end member (50) attached to one end of the bar and a second end member (16) attached to another end of the bar. The first end member removably attaches to the one end of the bar (Figs. 1-4); (b) mounting the bar

of the stud in an aperture formed in a wearer's earlobe (Fig. 2); and (c) dispensing the substance into the earlobe (C. 3, L. 3-10). Edwards teaches that the stud serves to conveniently and effectively deliver medication to an aperture in an earlobe during the healing period following a piercing operation (C. 1, L. 32-35) and the stud serves to apply medication to the interior of the aperture in the earlobe (C. 3, L. 9-10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a method for dispensing a substance where the stud includes a means for dispensing a substance formed in a portion of the stud where the means for dispensing the substance contains the substance and the substance being dispensed as taught by Edwards in the method disclosed by Kaping with the stud is being used in the mouth and therefore the substance will be dispensed into the wearer's mouth since the fistula formed in the mouth or tongue is also prone to infections during the healing period following a piercing operation. Doing so, serves to deliver medication conveniently and effectively to a fistula in the wearer's mouth and tongue since both devices deal with piercing on the body. Additionally, Edwards teaches that the stud provides a known technique of dispensing a substance in order to combat infections during the healing period following a piercing operation and therefore it would have been obvious to one having ordinary skill in the art that the stud applying medication to the interior of the fistula in the wearer's mouth and tongue where the medication is selected from a medication for use in the user's mouth just like the stud serves to deliver medication to an aperture in the earlobe during the healing period following a piercing operation. Kaping and Edwards fail to disclose that the substance is dispensed

Art Unit: 3677

into the wearer's mouth by dissolving the substance over time in the wearer's saliva so that the dissolved substance flows from the means for dispensing into the wearer's mouth, however, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention that the substance will be dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva so that the dissolved substance flows from the means for dispensing into the wearer's mouth since after the substance is ejected from the reservoir (16), for the first time or any subsequent time, a vacuum is created in the reservoir and this vacuum will allow the flow of fluids into the reservoir. Since the stud is located in the wearer's mouth a mixture of air and saliva can flow into the reservoir. The saliva that flows into the reservoir will mix with the substance and dissolve the substance over time in the wearer's saliva and eventually the dissolved substance flows from the means for dispensing into the wearer's mouth.

### ***Allowable Subject Matter***

8. Claims 38, 39, 42-45, 48 and 49 are allowed.

### ***Response to Arguments***

9. Applicant's arguments filed 25 March 2009 have been fully considered but they are not persuasive.

10. Applicant's arguments with respect to claims 36, 37 and 46 have been considered but are moot in view of the new ground(s) of rejection.

11. The applicant argues that *KSR International Co. v. Teleflex Inc.*, 127 St. Ct. 1727, 1742 (2007) establishes when a proper rejection under Section 103 is possible in accordance with the teaching of the references and that the rejection should not rely in the applicant's disclosure. The applicant argues that the rejection fails to establish a prima facie case of obviousness when combining Abramowitz and Kaping or Edwards and Kaping since the references fail to teach every limitation, the reasons provided for the combination are not legitimate and that the combination is not enabling. These arguments fail to persuade. *KSR International Co. v. Teleflex Inc* establishes the different rationales that can be properly used to make rejection under Section 103. The combination of these references is legitimate under several rationales. The first one can be combining prior art elements according to known methods to yield a predictable result. The mouth is prone to infections just like any other part of the body. Body members being pierced are susceptible to infections especially when the body members have been recently pierced. The use of earrings to dispense medication into the body members that are pierced in order to prevent or fight infections is well known in the art as disclosed by Abramowitz and Edwards. The use of earring in body piercing for different body members is well known as taught by Kaping. Lefkowitz teaches that the use of medication for internal use in a wearer's mouth is well known. Therefore, a person of ordinary skill in the art will acknowledge that combining the elements of Abramowitz, Kaping and Lefkowitz or Edwards, Kaping and Lefkowitz will yield the

predictable results of providing a device that will prevent or fight infections in the wearer's mouth by using the studs that will dispense the medication into the wearer's mouth. Similarly, the use devices of Edwards and Abramowitz for dispensing breath fresheners and flavoring agents is also obvious since the devices of Abramowitz and Edwards can also be used to dispense a perfuming agent. Another rationale that can be applied is the use of known techniques to improve similar devices. The studs being disclosed by Kaping, Abramowitz and Edwards are used in body piercing. Kaping teaches that a stud device can be use in any pierced body member. When these references are combined the known technique of prevent or fight infections or dispensing a perfuming agent by the use of an earring will improve the way infections are treated in the pierced members of a mouth or can provide a way how dispense a perfuming agent within the mouth. Another rationale that can be applied to justify the combination is that it will have been obvious to try since there is reasonable expectation of success. The use of the devices of Abramowitz and Edwards have been successfully used to treat infections or to apply a perfuming agent to a pierced body member externally. Therefore, the successful treatment of an infection or the application of a perfuming agent internally has reasonable expectation of success since Kaping teaches that the device can be used in any pierced body member and Lefkowitz teaches the use of internal medications, breath fresheners and flavoring agents in the mouth.

12. The applicant argues that the device of Abramowitz is a syringe and that it can not be considered a mouth and tongue stud. This argument fails to persuade. The device of Abramowitz can be considered a syringe since it ejects medication, however,

this device can also be considered a stud since Abramowitz teaches that the device remains engaged to the pierced opening. Additionally, there is nothing blocking the entrance to the reservoir and therefore the substance can be dispensed even when the end member is not pressed. Therefore, the device disclosed by Abramowitz can be considered a mouth and tongue stud when this device that can be used in the mouth in accordance with the teaching of Kapling.

13. The applicant also argues that Abramowitz fails to disclose that the substance can be dissolved “over time in the wearer’s saliva so that the dissolved substance is free to flow from the means for dispensing into the wearer’s mouth”. This argument fails to persuade because the device of Abramowitz does not have any interruptions that prevent free flow of the substance from the stud into the mouth and the saliva can enter the stud and dissolved over time into the wearer’s mouth just like the substance can travel out of the stud.

14. The next argument is that the device of Abramowitz is for external use only. This argument fails to persuade because Abramowitz is not being used to reject the claims by itself. Therefore, the combination of the references should be considered. The device of Abramowitz is disclosed for external use, however, Kapling teaches that is well known within the body piercing art to use an earring in any piercing in the body such as the mouth. A person of ordinary skill in the art will recognize that medication, breath fresheners and flavoring are commonly used in the mouth when a person experiences infections as taught by Lefkowitz and therefore the combination of Abramowitz, Kapling

and Lefkowitz can be used internally when taking into consideration the teachings of Kaping and Lefkowitz.

15. The Applicant argues that the device taught by Edwards has a retainer (52) held in place by friction and that such a retainer is undesirable for use in the mouth. This argument fails to persuade since the rejection is not incorporating the retainer 52. The rejection is based in the patent by Kaping that discloses two ends that are securely held to the bar and the elements being incorporated into the device of Kaping are the end 16 and the perforated bar 30. The retainer 52 is not incorporated into the device since Kaping already has another end that remains unchanged.

16. The Applicant argues that the stud can not be used to enhanced sexual activity since the end 16 is compressible. This argument fails to persuade since one of the solid ends disclosed by Kaping that will remain unchanged in the device can serve to enhance sexual activity.

17. The Applicant argues that the device of Edwards is a syringe and that it can not be considered a mouth and tongue stud. This argument fails to persuade. The device of Edwards can be considered a syringe since it ejects medication, however, this device can also be considered a stud since Edwards teaches that the device remains engaged to the pierced opening. Therefore, the device can be considered a mouth and tongue stud when this device is used to modify the mouth and stud device that is disclose by Kaping. Additionally, there is nothing blocking the entrance to the reservoir and therefore the substance can be dispensed even when the end member is not pressed. Therefore, the device disclosed by Edwards can be considered a mouth and

tongue stud when this device that can be used in the mouth in accordance with the teaching of Kaping.

18. The applicant also argues that Edwards fails to disclose that the substance can be dissolved “over time in the wearer’s saliva so that the dissolved substance is free to flow from the means for dispensing into the wearer’s mouth”. This argument fails to persuade because the device of Edwards does not have any interruptions that prevent free flow of the substance from the stud into the mouth and the saliva can enter the stud and dissolved over time into the wearer’s mouth just like the substance can travel out of the stud.

19. The next argument is that the device of Edwards is for external use only. This argument fails to persuade because Edwards is not being used to reject the claims by itself. Therefore, the combination of the references should be considered. The device of Abramowitz is disclosed for external use, however, Kaping teaches that is well known within the body piercing art to use an earring in any piercing in the body such as the mouth. A person of ordinary skill in the art will recognize that medication, breath fresheners and flavoring are commonly used in the mouth when a person experiences infections as taught by Lefkowitz and therefore the combination of Edwards, Kaping and Lefkowitz can be used internally when taking into consideration the teachings of Kaping and Lefkowitz.

20. The applicant argues that Lefkowitz fails to disclose a tongue and mouth stud or that the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva. The Examiner fails to be persuaded by this argument



since Lefkowitz is being used for its teaching of dispensing medication or a combination of medication with breath freshener or flavoring into the wearer's mouth and not because it can be a stud or that the substance is dispensed into the wearer's mouth by dissolving the substance over time in the wearer's saliva.

21. The next argument is that the examiner speculates that some of the substance remaining in the stud will be dissolved by the wearer's saliva by back flowing and that the dissolved spontaneously flows from the stud or is subsequently ejected from the stud. The Examiner fails to be persuaded by this argument. The claims fails to recite which member of the stud is the means for dispensing the substance. One possible interpretation can be that the elongated slot disclosed by Edwards or Abramowitz can be considered the means for dispensing the substance since it contains the substance after it is ejected from the end member. Some of the substance will remain in the elongated slot of the bar and the saliva can enter the slot and be dissolved with the substance over time since the elongated slot is an open structure and the saliva can freely enter the slot. The other possible interpretation is as cited in the rejection when backflow causes saliva to enter the end member. The aperture that connects the end member to the bar does not any obstruction that will prevent the saliva from entering or exiting the end member. Therefore, the end member is also capable of dispensing the substance to wearer's mouth by dissolving with the wearer's saliva over time.

22. The Applicant argues that In re Newell provides support to this position that the claimed invention will not be obvious by using the cited references because none of the references teaches the limitations of dissolving the substance over time in the wearer's

Art Unit: 3677

saliva since inherency is required for the combination. Especially since *In re Newell* establishes that a prima facie case can not be established using “retrospective view of inherency”. This argument fails to persuade. The Examiner acknowledges that none of the references recite this limitation. However, the test for combining the references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. Edwards and Abramowitz fails to disclose that the use of saliva since these references are directed to external use where saliva is not present. However, Kaping teaches that use of earrings in other body member such as the mouth is well known in piercing art. A person of ordinary skill in the art will acknowledge that the saliva is capable of flowing through any surface provided in the mouth. Therefore, the saliva will flow through any surface of the stud disclosed by Edwards of Abramowitz since these studs do not provide any closing structure that will prevent the movement of saliva through the stud. The case of *In re Newell* establishes that retrospective view are impermissible if there is not way to determine whether the device can perform the claimed function. However, in this case any person of ordinary skill in the art will understand that the saliva that is provided in the wearer's mouth can flow freely within the mouth unless something is used to block its passage and as such it can enter the cavities provided in the stud so as to dissolve the substance.

23. The Applicant also argues that the saliva entering the elongated slot and the end members will not flow since it will form a plug. This argument fails to persuade. Fluid mechanics establishes that a fluid can flow through any conduit as long as there is not obstruction that will prevent its movement. The stud disclosed by Edwards or

Art Unit: 3677

Abramowitz does not have any obstruction that will prevent the flow of the saliva and the saliva can flow freely.

24. The Applicant argues that the combination is improper because there is no reason to combine the references of Kapling and Abramowitz or Kapling and Edwards. The Examiner fails to be persuaded by this argument because “Abramowitz teaches that the stud serves to conveniently and effectively deliver medication or perfume to an aperture in an earlobe allowing healing of the ear and clearing up of infections (C. 1, L. 37-48).” as recited above for the rejection of the claims and “Edwards teaches that the stud serves to conveniently and effectively deliver medication to an aperture in an earlobe during the healing period following a piercing operation (C. 1, L. 32-35) and the stud serves to apply medication to the interior of the aperture in the earlobe (C. 3, L. 9-10).” as recited above. The combination of Kapling and Abramowitz or Kapling and Abramowitz will yield a mouth and tongue stud that serves to deliver medication to a fistula formed in the wearer’s tongue or in the wearer’s lip since the fistula also experiences healing after the fistula is formed or it can experience infections. The Examiner acknowledges that the medication used in the mouth is different from the medication used in the earring since they are located in different environments. A person of ordinary skill in the art can determine that the medication used for the mouth and tongue stud needs to be different from the medication being used with the ears because of their locations. Additionally, there is a wide selection of the appropriate medications for use in the mouth that is commonly used to treat infections and a person of ordinary skill in the art will use select these medication when treating the mouth.

25. In response to applicant's argument that there is no reasonable expectation of success even if the combinations were made, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Abramowitz and Edwards teach that medication can be dispensed through a stud placed in a body piercing and both structures will perform its function of dispensing a substance equally as well regardless of whether it is located in the mouth or in the ear.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RUTH C. RODRIGUEZ whose telephone number is (571) 272-7070. The examiner can normally be reached on M-F 07:15 - 15:45. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor D. Batson can be reached on (571) 272-6987.

Submissions of your responses by facsimile transmission are encouraged. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-6640.

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